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SEP 29 2006

OFFICE OF PETITIONS

In re Application of :
Lochtefeld :
Application No. 10/056,893 :
Filed: January 22, 2003 :
For: SURF TOY ACTION FIGURE AND :
SIMULATED SURFING GAME :

ON PETITION

This is a decision on the petition filed December 29, 2004, which is being treated as a renewed petition under 37 CFR 1.181(no fee) to withdraw the holding of abandonment. The delay in treating this petition is sincerely regretted.

The petition to withdraw the holding of abandonment is **dismissed**. Any renewed petition must be filed within TWO MONTHS. See 37 CFR 1.181(f). Extensions of time under 37 CFR 1.136(a) or (b) are not available. Any renewed petition to withdraw the holding of abandonment must be clearly captioned as such, or as explained below as a petition to revive under 37 CFR 1.137.

This application became abandoned for failure to properly reply within the meaning of 37 CFR 1.116 and 35 U.S.C. § 133 to the final Office action of December 29, 2003, which set a shortened statutory period for reply of three months. While a reply and a timely request (within the meaning of 37 CFR 1.8) and fee for a 2 month extension of time were filed June 1, 2004, the reply did not *prima facie* place the application in condition for allowance; witness the lack of a Notice of Allowance. While an Advisory Action has not been mailed, as indicated in the Group Director's decision of November 1, 2004, the Supervisory Patent Examiner (SPE) has determined that the reply did not *prima facie* render this application allowable, and further raised new issues. Accordingly, this application became abandoned at midnight on May 29, 2004. A Notice of Abandonment was mailed August 2, 2004.

Petitioner requests that the holding of abandonment be withdrawn in that the amendment allegedly did *prima facie* place this case in condition for allowance. Petitioner notes while that in the final Office action, claims 1 through 15, and 19 were rejected, dependent claims 17 and 18 were indicated as allowable, and as the amendment submitted after final merely placed, in the the alternative, limitations of these 2 claims into claim 1, petitioner reasons that claim 1 and all claims dependent thereon were thereby rendered allowable.

It is agreed that including the limitations of dependent claims 17 and 18 (claims with indicated allowable subject matter) into claim 1 by using alternative language and limiting the control mechanism to either a weight or a magnet would not raise a new issue by itself. However, petitioner overlooks the effect of that amendment to claim 1 on dependent claim 19.

The Technology Center has determined the amendment raises at least one new issue in that the proffered amendment to claim 1 now sets forth a control mechanism comprising either a weight or a magnet while claim 19 sets forth that the control mechanism comprises a radio controlled transmitter and receiver/actuator. It is not clear to the Technology Center that the

originally filed specification provided adequate support for a control mechanism of a radio controlled transmitter *in combination with* either a weight or a magnet as set forth by claim 19.

Therefore, the Technology Center reasons, the presence of at least claim 19, as proposed to be dependent on amended claim 1 means that applicant's proposed amendment under 37 CFR 1.116 did not *prima facie* place the case in condition for allowance.

Accordingly, the Technology Center has set forth a reasonable basis for maintaining the holding of abandonment, notwithstanding the filing of the amendment of June 3, 2004.

Petitioner may wish, instead of further renewing the petition to withdraw the holding of abandonment, to now seek revival under 37 CFR 1.137. See MPEP 711.03(c), subsection II.


Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries related to this decision only should be directed to the undersigned at (571) 272-3217.


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